

REMARKS

Amendment

Claims 1, 5, 14, 18, 23, 29 and 35 have been amended to require that the first sidewall and second sidewall of the taco shell are interconnected only by a substantially flat base. This amendment is supported by the original specification, particularly at paragraph [0013] and by Figures 2 and 4. Claim 42 additionally has been amended to depend from claim 23, thereby additionally incorporating the limitation that the first sidewall and second sidewall of the taco shell are interconnected only by a substantially flat base. Claims 24, 25, 30 and 31 have been amended to correct a minor typographical error.

Response to Rejections

Claims 1-53 are pending in the application and have been rejected.

Claims 1-53 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Gornet (D376,893) in view of Gornet (D393,136), Gornet et al (D369,451) and Beehler (5,993,871), further in view of Bank (D277,234), Ruiz (5,002,783), Stickle (D335,758), Kittleson (D339,899), Ito (5,298,273), Hutchinson (D251,396), Alsbrook (5,567,455), Biggs et al (5,709,898), further in view of Richards (D278,199), and Putt (D282,338).

All claims have additionally been rejected using the same group of references, but using Beehler as the primary reference.

The present invention as claimed is directed to a taco shell having a unique configuration that affords significant benefits in providing a self-standing taco shell in a geometrically simple, pleasing and functional shape. In the inventive taco shell as claimed, first and second sidewalls that are interconnected only by a substantially flat base. At first blush, the presently claimed configuration seems ordinary because the uniqueness of the design is subtle. On the one hand, the taco shell design presents a

traditional look and feel of a taco shell that customers have come to expect when they seek a taco-eating experience. On the other hand, the present taco shell surprisingly can stand on its own without further support, which solves the problem of prior art taco shells that must be laid on their side when not being held by the consumer, leading to spillage of the contents. See paragraph [007]. This flat bottom configuration of the present shell provides unique benefits in stability, taco ingredient capacity, ease of taco loading and handling, and superior performance even on failure of the shell. In particularly preferred embodiments, the taco shell is configured to have a specific height to width ratio and specific height and width measurements to facilitate both stability and ease of handling during consumption by the end user. See paragraphs [0009] and [0010]. Additionally, the present taco shell is easy to manufacture as compared to more complex shaped shells that might be envisioned or have been described in the prior art.

The uniqueness of the presently claimed taco shells is supported by the fact that this product has been recognized in the food industry as an excellent new product. Specifically, Old El Paso STAND 'N STUFF kit, which contains the self-standing taco shell of the present invention, was presented with the prestigious "Canadian Grand Prix Best New Product" award in the Prepared Foods category on May 28th, 2007 in Ottawa, Canada. This award is sponsored by the Canadian Council of Grocery Distributors, and recognizes new products that exemplify product excellence and success in their respective categories. The award recognizes new product leadership, and highlights product ingenuity for consumers. See <http://www.ccgd.ca/home/en/PDF/Grand%20Prix/2006%20GP%20Winners%20Press%20Release%20-%20English.pdf>

Gornet '893 is a design patent that discloses a configuration for an edible container comprising four interconnected sidewalls and a connected bottom. The container as shown in this reference is a rectangular "open box" container that would be rigid and would therefore be difficult to eat in view of the hard corners that would be presented to the consumer. Gornet '893 cannot anticipate the presently claimed taco shell having first and second sidewalls, because the present claims contain an express

limitation that the shell does not have connective sidewalls, but rather requires that the first and second sidewalls are interconnected only by a substantially flat base.

Gornet '893 additionally does not render the presently claimed taco shell obvious, because the nature of the Gornet '893 disclosure teaches away from the presently claimed shell configuration. Gornet '893 seeks to present a unique design that introduces a new product category, which is a tortilla shell in the shape of an open box. This product alters the expectations of the consumer because it does not look like a conventional taco shell. In contrast, the presently claimed stable, self-standing, taco shell does not look like a box, but instead more closely presents the traditional look and feel of a conventional taco shell. The skilled artisan would have had no reason to modify the unique new product design of Gornet '893 to instead provide a performance benefit in a traditional looking taco shell as provided by the present claims. The change from the prior new product box shaped tortilla shell to the presently claimed structure requires invention that cannot be derived from the prior art of record.

The Office Action specifically cites the combination of Gornet '893 in view of Gornet '136 and Gornet '451 to describe shell constructions having flat bases. However, both Gornet '136 and Gornet '451 describe tortilla shell constructions that are configurations for edible containers comprising four interconnected sidewalls and a connected bottom. The containers as shown in these references show generally rectangular "open box" containers that would be rigid and would therefore be difficult to eat in view of the hard corners that would be presented to the consumer. The skilled artisan would have no reason to modify the Gornet '893 product configuration in view of these secondary references, because they all fall short of the present claims in the same manner.

Beehler is cited as providing evidence of taco shells having substantially flat bases. It is respectfully submitted, however, that Beehler does not disclose a taco shell construction that has a substantially flat base.

Beehler describes an edible food container that is self-supporting and stable in a generally upright position when placed on a rigid and substantially planar support surface. However, the structure of Beehler includes a base having an intermediate portion critically having curvilinear or "W" cross section, rather than the flat or planar

base feature of the presently claimed taco shell. Importantly, Beehler **explicitly** and **specifically** teaches directly away from using a flat bottom taco shell configuration in its Background section of the '871 patent, stating:

“...due to the variation in the surface topology of taco shells, the flat base shell does not provide coplanar support points and, instead, provides a plurality of support points at different elevations which causes the taco shell to be unstable when it is supported by its base.”

See column 1, lines 34-44.

Upon identifying a perceived problem with flat bottom taco shells, Beehler expressly teaches an alternate configuration wherein first and second sides and a base are provided that connects the first and second sides to form a generally W-shaped base. The base includes at least two spaced apart line bearing contact surfaces for supporting the edible food container in a generally upright position on a substantially planar surface. See the Abstract. Also, Beehler is completely silent in respect of the general importance of and the specific criticalities of the height to width ratios presently recited in claims 1 and 14, and claims depending therefrom. The skilled artisan thus would have been specifically steered away from the presently claimed taco shell configuration by Beehler, and would have had no reason to consider height to width ratios as required in the above mentioned claims.

Because the configuration of the base of the taco described in Beehler is expressly not flat, but instead is purposefully configured to provide two spaced apart line bearing contact surfaces, Beehler cannot be said to teach a flat based taco shell construction as the presently claimed.

Bank '234, Ruiz '783, Stickle '758, Kittleson '899, Ito '273, Hutchinson '396, Alsbrook '455, and Biggs '898 are all relied upon as further evidence of the conventionality of flat bottomed edible containers.

Bank '234, and Hutchinson '396 are similar to Gornet '893, because they disclose edible containers comprising four interconnected sidewalls and a connected bottom. The container as shown in this reference is a rectangular “open box” container that would be rigid and would therefore be difficult to eat in view of the hard corners that would be

presented to the consumer. The skilled artisan would have no reason to modify the Gornet '893 product configuration in view of these references, because they all fall short of the present claims in the same manner.

Ruiz '783 and Stickle '758 describe variants of the now familiar "taco salad" bowl shape that is eaten not as a hand-held food item, but as an edible salad container using a fork or other eating implement. The bowl of Ruiz does not contain a first sidewall and a second sidewall that is interconnected only by a substantially flat base. The base of Ruiz is not flat, but instead is provided with annular beads 16 and 17 that provide reinforcement and consequently a non-flat bottom of the bowl. See column 4, lines 10-18. Likewise, the bowl of Stickle '758 does not contain a first sidewall and a second sidewall that is interconnected only by a substantially flat base. Instead, the bowl of Stickle '758 contains 16 sidewalls connected at alternating angles to form an open bowl container for receiving a salad. Such a configuration does not teach or suggest the presently claimed taco shell, which by express limitation does not have sidewalls that connect the first and second sidewalls.

Kittleson '899 does not describe a taco shell at all, but rather describes a pizza crust configuration. It is respectfully submitted that the properties of pizza crusts and taco shells are fundamentally different because the standing stability and other organoleptic considerations are so different in these product categories. Most prominently, there are distinct differences in the stiffness and texture between a pizza crust and a taco shell that are immediately apparent to both the skilled artisan and the casual end-user that, absent mere cursory review of a drawing in the abstract, dictate that these product categories are considered to be very distinct in the art. Kittleson '899 therefore relates to a nonanalogous art with respect to both the primary reference and the subject matter of the present claims, and therefore cannot properly be combined with the references as proposed in the outstanding Office Action.

Ito '273 describes formation of cup-shaped containers, and therefore fails to bridge the gap between Gornet '893 and the presently claimed taco shell configuration that requires that the first and second sidewalls are interconnected only by a substantially flat base.

Alsbrook '455 describes a salad sandwich made of a baked edible shell that is open at one end and contains a tear-away bag that is filled with an appropriate sandwich fill. The tear-away bag keeps the sandwich fill fresh and prevents the sandwich fill from transferring moisture to the shell. The tear-away bag has a tear-away mechanism that allows the bag to be removed in one step without removing the sandwich fill from the confines of the shell. See the Abstract. The edible shell is described as being formed into a shape suitable for containing the sandwich fill, such as "that of a rectangular box, as is shown in the attached drawings, or the edible shell can have a pocket shape, tubular shape or any shape suitable for containing the sandwich fill." See column 3, lines 19-24. Therefore, Alsbrook '455 fails to bridge the gap between Gornet '893 and the present claimed taco shell configuration that requires that the first and second sidewalls are interconnected only by a substantially flat base.

Biggs '898 describes a process for the manufacture of a food product comprising a wafer filled with a food core. The process includes the steps of: (i) shaping the food core; (ii) heating at least part of the wafer in order to provide sufficient plastic properties to the wafer to shape; and (iii) shaping the wafer around the pre-shaped food core, the food core acting as a former. See the Abstract. This process is particularly desirable for use in the ice cream industry, where ice cream can be provided in a partially open wafer configuration by first freezing the ice cream and then building the wafer around the ice cream. Because the wafer as described in Biggs '898 is formed around the food core, the wafer is never in a state in which it is capable of accepting food filling material. Because the Biggs product is never in a state to properly act as a taco shell, the skilled artisan would find this to be non-analogous art and would not consider this reference in designing taco shells or in carrying out the presently claimed methods. Further, the advantages that are found in the present product cannot be achieved in the Biggs product configuration, because the Biggs wafer is never in a self-supporting status without food product already being securely disposed within the wafer.

Richards '199 and Putt '338 describe taco holders, and not taco shells themselves. These references are cited for the purpose of showing that one can make an article self-standing by providing a flat bottom. It is respectfully submitted that these references support patentability of the present invention, because they solve the problem of taco

shells that do not stand up on their own in a different way. These references teach that one must use a holder or stand to prop up the taco, and completely ignore the present solution of changing the shape of the taco shell itself. The skilled artisan would have had no reason to modify the shape of the taco shell in the manner presently claimed in view of these references, because the references themselves would be expected to solve the problem. Being provided with one solution from the prior art, the artisan must exercise separate inventive effort to seek out a different solution that is not apparent from the disclosure of the references. One envisions the present taco shell configuration by reference to the cited art only by having the benefit of knowing the present claims. Such hindsight is not permitted.

The Office Action additionally restates the rejection of the above discussed claims, using Beehler as the primary reference. As noted above, Beehler describes an edible food container that is self supporting and stable in a generally upright position when placed on a rigid and substantially planar support surface by using a base structure having a “W” shaped cross section rather than the flat or planar base as required in the present claims. Importantly, Beehler **explicitly** and **specifically** teaches directly away from using a flat bottom taco shell configuration in its Background section of the ‘871 patent. See the discussion re Beehler above.

The entire focus of the Beehler construction provides that the base has at least two spaced apart line bearing contact surfaces for supporting the edible food container in a generally upright position on a substantially planar surface.

The skilled artisan therefore would have been specifically steered away from the presently claimed taco shell configuration by Beehler. To change the configuration of the Beehler taco shell to require a flat bottom frustrates the very essence of this disclosure, and is not permissible as a matter of law. In view of the express purpose of the Beehler configuration, combination of Beehler with any reference to alter the nature of the base structure of the taco shell as disclosed therein is manifestly improper.

The Office Action goes on to suggest that the Beehler reference could be considered to disclose a “substantially flat” bottom, stating that this term is not defined in

the present specification. It is respectfully submitted that the meaning of recited claim feature is clear to the skilled artisan, particularly in view of the explanatory descriptions the nature of taco shells as provided in the present disclosure. The present specification explains that a taco shell will have normal variations in surface topography simply by the nature of taco shell material, and notes that the base is sufficiently broad so that the taco can be stable in an upright position and overcomes the destabilizing effect presented by these normal variations. See page 7, lines 15-17 and 22-27. It is submitted that the term "substantially flat base" as presently used clearly and succinctly describes a base having a simple geometrically flat configuration, allowing for the normal variations in surface topography that results during cooking of a taco shell material.

In contrast, Beehler expressly describes a base having a pair of "elongate spaced apart ribs," or a base "having a generally raised portion intermediate the generally parallel line bearing contact surfaces," or a base having an "undulating cross-section." See column 1, line 64 - column 2, line 2, and column 2, lines 50-51. It is respectfully submitted that there is no way one could consider the base of Beehler to be substantially flat in view of the discussion of this term in the present disclosure and the teachings of Beehler.

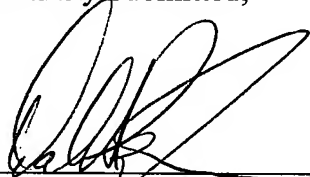
It is respectfully submitted that the present claims as amended are patentable over the art of record. Reconsideration and withdrawal of all outstanding rejections is therefore earnestly solicited.

CONCLUSION

In view of the above remarks and amendments, it is respectfully submitted that the foregoing is fully responsive to the outstanding Office Action. Early favorable consideration of the above application is earnestly solicited. In the event that a phone conference between the Examiner and the Applicant's undersigned attorney would help resolve any issues in the application, the Examiner is invited to contact said attorney at (651) 275-9811.

Respectfully Submitted,

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